

Attorney's Docket:  
00P7493US

PATENT APPLICATION  
09/516,908

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AMENDMENT

Official  
4/15/03

Sir:

In response to the Office Action of January 16, 2003, please amend the above identified application as follows:

In the claims:

Please amend claim 5 as follows:

a1 5. (Amended) A method according to claim 2 wherein said sending a test is initiated in response to a user login.

REMARKS

Claims 1-20 are pending. Claim 5 has been amended.

Drawings

The Patent Office stated that the drawings filed on March 1, 2000 have been approved.

Thank you.

Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claims 1, 4, 6-12 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,253,246 by Nakatsuyama et al. ("Nakatsuyama"). Claims 2-3, 5 and 13 are rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,253,246 by Nakatsuyama et al. ("Nakatsuyama") in view of Maddalozzo, Jr. et al., U.S. Patent No. 6,105,029 ("Maddalozzo").

Applicants respectfully traverse the rejection of these claims for the following reasons. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a

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whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See* MPEP § 2141 and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

The present invention is directed to the intelligent and efficient management of message and data files of various compressions based upon a current connection speed. Independent claims 1, 12, 17 and 20 each include elements which have not been disclosed, taught, or suggested by Nakatsuyama, as noted by the admissions of the Patent Office. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

The primary reference, Nakatsuyama, is relied upon for its teaching of a data service system. As noted by the Examiner, the Nakatsuyama reference, fails to teach or suggest a step of determining whether to send an original data file as recited in claim 1. The Examiner rejected claim 17 on the same basis as claim 1 without any explanation of how each of the elements of claim 17 were taught or suggested by Nakatsuyama. Further, as noted by the Examiner, the Nakatsuyama reference also fails to teach or suggest a step of receiving from user data indicating a desired compression option as recited in claim 12. Additionally, claim 20 includes, an element of presenting a transfer time for the original message to the user, which the Examiner states is not taught or suggested by Nakatsuyama.

As a result, the Examiner states that at least three elements of independent claims: a step of determining whether to send an original data file; a step of receiving from user data indicating a desired compression option; and presenting a transfer time for the original message to the user are not taught or suggested by Nakatsuyama. Claim 6 and claim 11 include elements that, as noted by the Examiner, are not taught or suggested by the Nakatsuyama reference. Claim 6 includes the element of receiving an indication from a user as to what compression format is decodable by the user system and claim 11 includes an element of compressing data dependent upon a comparison between the transfer time and a maximum acceptable delay. However, the Examiner states that a person of ordinary skill in the art would have been motivated to add all of the at least five separate and distinct elements, described in claims 1, 6, 11, 12, 17 and 20, none

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of which were taught or suggested by Nakatsuyama, without any support of another reference and without any evidence of motivation.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. MPEP § 2143.01. Further, the Examiner must consider the claimed invention "as a whole" and must put aside knowledge of Applicant's disclosure in reaching a determination of obviousness. MPEP § 2141.02. However, the present rejection contains only the Examiner's statements that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nakatsuyama's with the determining step to improve the performance of the invention.

and that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nakatsuyama's with the selecting step to attract more clients.

As the Examiner is well aware, Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. MPEP § 2144.03. Therefore, in accordance with Applicants' duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting his position that it would be obvious modify the references suggested by the Examiner. If the Examiner is unable to provide such a reference, and is relying on facts within his own personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. § 104(d)(2). Absent substantiation by the Examiner, it is believed that the Examiner has impermissibly attempted use the teaching of Applicant's specification to modify the Nakatsuyama and Mondalozzo references to achieve Applicants' claimed invention, and it is requested that the rejection under 35 U.S.C. § 103 be withdrawn. MPEP § 2142; *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In Re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

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Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Withdrawal of the rejections of claims 1-20 under 35 U.S.C. § 103(a) is therefore requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made."

### CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

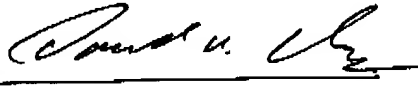
If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

While it is believed that no fees are required, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Corporation.

Date: 14 Apr 03

Respectfully requested,

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**Version With Markings To Show Changes Made**

**In the claims:**

Claim 5 has been amended as follows:

5. (Amended) A method according to claim 2 ~~+~~ wherein said sending a test is initiated in response to a user login.